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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,312	12/04/2003	Dieter Hochrainer	821-011725-US(PAR)	9650
28501	7590	06/14/2006	EXAMINER LEWIS, AARON J	
MICHAEL P. MORRIS BOEHRINGER INGELHEIM CORPORATION 900 RIDGEBURY ROAD P. O. BOX 368 RIDGEFIELD, CT 06877-0368			ART UNIT 3743	PAPER NUMBER

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/728,312

Applicant(s)

HOCHRAINER, DIETER

Examiner

AARON J. LEWIS

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 21 and 22 are objected to because of the following informalities: In claim 21, line 21, "...the inner surface..." does not have proper antecedent basis; in claim 21, line 22, "...the outer surface..." does not have proper antecedent basis; in claim 22, line 18, "...the inner surface..." does not have proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claims 21 and 22, the phrase "of the sort" in lines 2 and 5 of claim 21; and in line 1 of claim 22, renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "of the sort"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

4. Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, lines 14-18, the capsule chamber is recited as being configured to enable a capsule to vibrate longitudinally and also transversely whereas the last line in claim 21 recites essentially no transverse movement of the capsule within the capsule chamber.

In claim 22, lines 11-15, the capsule chamber is recited as being configured to enable a capsule to vibrate longitudinally and also transversely whereas the last line in claim 22 recites essentially no transverse movement of the capsule within the capsule chamber.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentini et al. ('819) in view of Kladders ('114).

As to claim 21, Valentini et al. disclose an improved combination comprising a capsule and a medicinal powder inhaler device (figs.1-6) of the sort comprising, (a) a generally cylindrical capsule (C) having a longitudinal axis and containing a pharmaceutically active inhalable medicament, and (b) a medicinal powder inhaler device of the sort comprising, (1) a capsule chamber (B) for receiving the capsule, said capsule chamber having an inlet (H) proximate a first end, for admitting air into the chamber and an outlet (see apertures at bottom of mouthpiece A in fig.5), proximate a second end, which communicates with a mouthpiece (A), the axis of the chamber being the line running between the first and second ends, by means of which mouthpiece a patient can draw by inhalation a stream of air which flows from the inlet, through the capsule chamber, wherein it admixes with medicament which has been released from a

capsule that has been received by the chamber, thence through the outlet and finally from the mouthpiece from whence the patient may inhale the mixture of air and medicament, said capsule chamber being configured to enable a capsule received therein to vibrate longitudinally (in the direction of air flow) and also transversely (at right angles to the direction of flow) while remaining aligned substantially parallel to the chamber axis when air is caused to pass through the chamber in response to inhalation by the patient, and (2) means (D) for piercing a capsule placed into the capsule chamber, to thereby release medicament from the capsule into the capsule chamber, wherein said improvement comprises the inclusion of raised elements (in fig.5, see angled raised surface within which piercing means D are recessed) on either the inner surface of said capsule chamber or the outer surface of said capsule, which raised elements align the axis of the capsule with the axis of the capsule chamber and which constrain the capsule, when it vibrates within the capsule chamber, to move back and forth along its longitudinal axis with essentially no transverse movement.

To the extent, if any, that Valentini et al. lack raised elements on the inner surface of the capsule chamber, resort is had to Kladders, in a powder inhaler, which teaches raised elements (#7 and col.3, lines 47-49) on the inner surface of the capsule chamber for the purpose of limiting the play of the capsule within the chamber (6).

It would have been obvious to modify the inner surface of the capsule chamber of Valentini et al. to include raised elements thereon because it would have provided a means for limiting the play of the capsule within the chamber as taught by Kladders.

Claim 22 is substantially equivalent in scope to claim 21 and is included in Valentini et al. as modified by Kladders for the reasons set forth above with respect to claim 21.

Response to Arguments

7. Applicant's arguments with respect to claims 21 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of the art is cited to show relevant powder inhalers.

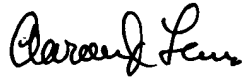
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON J. LEWIS whose telephone number is (571) 272-4795. The examiner can normally be reached on 9:30AM-6:00PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HENRY A. BENNETT can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


AARON J. LEWIS
Primary Examiner
Art Unit 3743

Aaron J. Lewis
June 11, 2006